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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,583	02/15/2002	Patric Enewoldsen	Mo-6780/LcA 35,006	1272
157	7590	02/11/2005	EXAMINER	
BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER

1774

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,583

Applicant(s)

ENEWOLDSEN ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in response to Applicant's amendment after final received 1/20/05. Because the Applicant cancelled dependent claim 15, and submitted a new independent claim 16 containing the exact claim language of claim 15, a new Office Action is presented below. Thus because of Applicant's amendment and because no other issues were raised that would require a new ground, the prior final rejection is reiterated below and this Office Action will be made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 16 (new) is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,733,651 to Wank et al.

Wank teaches a laminate comprising a colored layer. The laminate comprises films made from several different thermoplastic films. The laminate comprises a translucent polyurethane (PU) layer above a polycarbonate substrate or the PU layer can be the film itself (col. 9, lines 39-53) (functional equivalent to transparent PU layer). The colored layer is of a high-temperature resistant colored ink which is applied via screen printing. The PU layer is also applied to the colored layer via screen printing (col. 9, lines 39-43). See also col. 2, lines 39-50, col. 8, lines

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50-68, and Examples 1-4. The PU has a thickness of 2-80 micrometers (0.020 – 0.080 mm) (col. 9, line 44), which overlaps the range of Applicant of “at least 0.025 mm”. To the softening temperature of 140 to 180C and Shore A hardness of 50 to 95, these are merely inherent properties because the same material and thickness is provided for by Wank. That the laminate is prepared by the process as recited in instant claim 10 is a product by process claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant’s and prior art reference’s product are the same.

Response to Arguments

Applicant's arguments filed 1-20-05 have been fully considered but they are not persuasive. Applicant has cancelled dependent claim 15 and presented new claim 16 in independent form to attempt to overcome the 102(b) rejection over Wank et al. Amending claim 16 to be identical to that of claim 15, rewritten in independent form, does not make the case in condition for allowance. Applicant argues that the structure of the claimed laminate, determined by its recited steps preclude a cover film. Applicant specifically points to col. 11, lines 65 et seq. to teaching the printed decoration is protected from smearing and abrasion because it lies between a cover film and a support layer. However, Applicant does not preclude a cover film as

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alleged because the claims contain “comprising” language and as written can include additional layers. For example, in the instant claim 16, Applicant claims in step (iii) injecting into the mold a thermoplastic material to form a substrate, which could be construed as a cover layer or an additional layer. Applicant has not persuasively argued because the claim is a product by process claim, where the process limitations as written may include additional layers. The term “*comprises*” is open-ended and does not exclude additional elements or method steps. See MPEP 2111.03. See Wank, col. 12, lines 56-60 and col. 11, lines 60-68. The rejections are maintained for reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

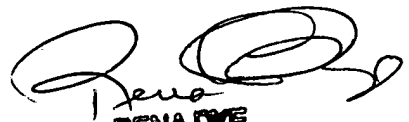
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

02/07/05



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 2/10/05